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EXAMINER

HANNAHER, CONSTANTINE

ART UNIT PAPER NUMBER

2878

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/819,074

Applicant(s)

ROSS ET AL.

Examiner

Constantine Hannaher

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION**Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 10, 11, 12, 15, 26, 17, 19, 20, and 22 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Duggan *et al.* (US006124594A).

With respect to independent claim 1, Duggan *et al.* discloses an apparatus (Fig. 2) for detecting the presence of an ophthalmic product in a container, comprising a source **12** of electromagnetic energy located relative to the container **1** to direct electromagnetic energy at the container, a non-imaging detector **13** disposed relative to the container **1** and the source **12** to detect electromagnetic energy from the source which interacts with the product and container in one or more of the recited ways, and means **15** for indicating the presence of the product in the container **1** responsive to one or more of the recited interactions of electromagnetic energy by the product (column 2, lines 28-30).

With respect to dependent claim 2, the product in the apparatus of Duggan *et al.* is a contact lens (column 1, line 7).

With respect to dependent claim 4, the source **12** in the apparatus of Duggan *et al.* emits electromagnetic energy having a wavelength in the infrared range (column 1, line 67).

With respect to dependent claim 10, the contact lens in the apparatus of Duggan *et al.* includes a media (at least one monomer having (meth)acrylate functionality) which interacts with electromagnetic radiation of a wavelength in a specified range in one or more of the recited ways, and the container **1** includes a receptacle **2** for the lens and is constructed from a material which interacts with the electromagnetic energy in one or more of the recited ways differently than does the lens (column 2, lines 16-19).

With respect to dependent claim 11, the contact lens in the apparatus of Duggan *et al.* includes a media (at least one monomer having (meth)acrylate functionality) which interacts with electromagnetic radiation having a wavelength in a specified range in one or more of the recited ways, and the detector **13** is sensitive to electromagnetic energy in the specified range (infrared, column 1, line 67 to column 2, line 1).

With respect to dependent claim 12, the apparatus of Duggan *et al.* further comprises a plurality of sources **12** and a plurality of detectors **13** disposed relative to each other for detecting the presence of a contact lens in a container **1** (column 2, lines 63-67).

With respect to dependent claim 15, the detector **13** in the apparatus of Duggan *et al.* is a spectrometer (column 2, lines 23-27).

With respect to dependent claim 26, the source **12** in the apparatus of Duggan *et al.* emits electromagnetic energy having a wavelength in the infrared range (column 1, line 67), the detector **13** is sensitive to the electromagnetic energy in the infrared range (column 2, lines 22-23), and the contact lens absorbs electromagnetic energy having a wavelength in the infrared range (column 2, lines 28-30).

With respect to independent claim 17, Duggan *et al.* discloses a method corresponding to the illustrated apparatus (Fig. 2) for detecting the presence of an ophthalmic product in a container, the

product including a media (at least one monomer having (meth)acrylate functionality) which interacts with electromagnetic energy of a frequency in a specified range (column 2, line 16) in one or more of the recited ways, comprising the steps of directing electromagnetic energy (from a source **12**) of a frequency in the specified range (column 2, lines 20-21) at the product and container **1**, detecting without imaging (with a detector **13**) electromagnetic energy which interacts with the product and container in one or more of the recited ways, and processing (with means **15**) the detected electromagnetic energy to determine the presence of the product in the container **1**.

With respect to dependent claim 19, the electromagnetic radiation in the method of Duggan *et al.* is in the infrared range (column 1, line 33).

With respect to independent claim 20, Duggan *et al.* discloses a method corresponding to the illustrated apparatus (Fig. 2) for detecting the presence of an ophthalmic product in a container, the product including a media (at least one monomer having (meth)acrylate functionality) which interacts with electromagnetic energy of a frequency in a specified range (column 2, line 16) in one or more of the recited ways, comprising the steps of directing electromagnetic energy (from a source **12**) at the product and container **1**, detecting without imaging (with a detector **13**) the absence of or reduction in electromagnetic energy of a frequency in a specified range which interacts with the product and container in one or more of the recited ways (column 2, lines 28-30), and processing (with means **15**) the detected electromagnetic energy to determine the presence of the product in the container **1**.

With respect to dependent claim 22, the electromagnetic radiation in the method of Duggan *et al.* is in the infrared range (column 1, line 33).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 5-7, 9, 13, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duggan *et al.* (US006124594A).

With respect to dependent claims 5-7 and 9, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the apparatus of Duggan *et al.* is indifferent to the composition of the contact lens as long as it has organic molecules containing "interatomic valence bonds which exhibit characteristic resonance frequencies in the IR range" (column 2, lines 9-12). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the recitation of the apparatus of Duncan *et al.* to encompass all contact lenses having this kind of organic molecule. The recited contact lenses of claims 5-7 and 9 are considered to have at least one such molecule.

With respect to dependent claim 13, the exact nature of the detector **13** in the apparatus of Duggan *et al.* is not specified. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Duggan *et al.* to specify any detector capable of detecting electromagnetic energy of the type emitted by source **12** and having interacted with the product in the container **1**. A calorimeter is known as a detector of infrared energy as emitted by source **12** and having interacted with the product in the container.

With respect to dependent claims 14 and 16, the presence of a filter would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the opportunity to reduce the detection of wavelengths other than the useful one identified (column 2, line 27).

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1-12, 23, 24, 13-22 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-24 of prior U.S. Patent No. 6,246,062. This is a double patenting rejection.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 25 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 4 of U.S. Patent No. 6,246,062. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious, in responding to absorption or reflection as stated in clause (c) of the independent claim that the detector must be sensitive to the wavelength range of the source emission. Furthermore, the recitation that the contact lens absorbs energy in that range is a generic expression of the recitation in the patent that the lens contains a tint. Also, it would have been obvious in including a source emitting in the infrared range to recite that the contact lens interacts with the emission in at least one of the three ways proposed by clause (c) of the independent claim.

Response to Submission(s)

10. The amendment filed October 23, 2002 has been entered.

11. Applicant's arguments filed October 23, 2002 have been fully considered but they are not persuasive.

12. The declaration filed on October 23, 2002 under 37 CFR 1.131 has been considered but is ineffective to overcome the Duggan *et al.* (US006124594A) reference.

13. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Duggan *et al.* (US006124594A) reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem.

The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The declaration does not establish possession of the whole invention claimed because the evidence is not commensurate with the scope of generic claims which recite “fluorescence, absorption or reflection” (claim 1) or “fluoresces, absorbs or reflects” (claims 17 and 20) in that the “description of the invention” offered as evidence does not convey to one skilled in that art that fluorescence of the product or component thereof is a part of the invention.

14. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Duggan *et al.* (US006124594A) reference. The single word “Yes” in response to a question “Tried experimentally or to be tried” is inadequate to assure that the invention had been reduced to practice in view of the “to be tried” aspect of the question.

15. The decision granting the petition mailed October 21, 2001 expected that the Examiner would make a statutory double patenting rejection under 35 U.S.C. 101 in view of the claims of the parent application. Only the fact that the specification (including the claims) was a copy of the application as originally filed rather than the application as it was before the request for a Continued Prosecution Application prevented the making of such a rejection. Now that the claims have been amended to their condition in the parent application as it went to issue, the rejection should have been completely expected.

16. The fact that claim 17 of the patent 6,246,062 recites a filter rather than a spectrometer as claim 15 of the application does is expected to be the result of an Office error which should have been addressed by a request for Certificate of Correction in the meantime.

17. For at least the reasons explained above, Applicant is not entitled to a favorable determination of patentability in view of the arguments submitted October 23, 2002.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

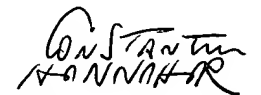
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (703) 308-4850. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (703) 308-4852. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

ch
January 29, 2003


CONSTANTINE HANNAHER
Examiner
U.S. Patent and Trademark Office